UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte SHINOBU TANAKA

Appeal No. 2005-1510
Application No. 09/883,279

ON BRIEF

Before FRANKFORT, PATE, and McQUADE, Administrative Patent Judges.
FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 and 2. Claims 3 through 9, the only other claims in the application, stand allowed.

As noted on page 1 of the specification, appellant's invention relates to a load handling apparatus for a counterbalance type forklift in which actions of lifting and lowering a fork, and tilting a mast are conducted by means of a single operating lever for handling a load. The load handling apparatus is configured so as to prevent the action condition from being suddenly changed by an erroneous operation, thereby

improving safety. A further understanding of the invention can be derived from a reading of claims 1 and 2 on appeal. A copy of those claims can be found in the Appendix to appellant's brief.

No prior art is relied upon by the examiner in rejecting the appealed claims.

Claims 1 and 2 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Rather than reiterate the examiner's commentary with regard to the above-noted rejection and the conflicting viewpoints advanced by the examiner and appellant regarding the rejection, we make reference to the examiner's answer (mailed April 6, 2004) for the reasoning in support of the rejection, and to appellant's brief (filed January 14, 2004) and reply brief (filed June 4, 2004) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we have made the determination that the examiner's rejection under 35 U.S.C. § 112, first paragraph, will not be sustained. Our reasons follow.

In rejecting claims 1 and 2 under 35 U.S.C. § 112, first paragraph, the examiner has urged that the specification fails to provide an enabling disclosure. More particularly, the examiner contends that:

> "[t]he second switching state is first said to enable lifting and lowering of the forks of a forklift truck. See the passage starting on line 10 starting with "that lifts..." and ending on line 11 with "in a second switching state". The next passage of the claim states that the lifting and lowering of the fork is not enabled while the switch is in the second switching state. Since the specification is not enabling for the second switching state to both enable and disable the lifting and lowering of the forks, it is not possible for the examiner to determine the intended scope of the claim. Claim 2 is also rejected as being dependent upon an unenabled claim. As the scope of claim 1 is not able to be

> determined at this time, the scope of claim 2 is also unable to be determined as well" (answer, page 3).

As a further explanation, in the paragraph bridging pages 5 and 6 of the answer, the examiner has made the determination that the term "switching states" as used in the claims on appeal "apply to the overall control system (reference numeral 7) and not to the position of the switch as asserted by appellant."

It is by now well-established law that the test for compliance with the enablement requirement in the first paragraph of 35 U.S.C. § 112 is whether the disclosure, as filed, is sufficiently complete to enable one of ordinary skill in the art to make and use the claimed invention without undue experimentation. In re Moore, 439 F.2d 1232; 169 USPQ 236 (CCPA 1971). See also In re Scarborough, 500 F.2d 560, 182 USPQ 298 (CCPA 1974). Moreover, in rejecting a claim for lack of enablement, it is also well settled that the examiner has the initial burden of advancing acceptable reasoning inconsistent with enablement in order to substantiate the rejection. See In re Strahilevitz, 668 F.2d 1229, 212 USPQ 561 (CCPA 1982); In re Marzocchi, 439 F.2d 220, 169 USPQ 367 (CCPA 1971). Once this is

done, the burden shifts to appellant to rebut this conclusion by presenting evidence to prove that the disclosure in the specification is enabling. See In re Doyle, 482 F.2d 1385, 179 USPQ 227 (CCPA 1973); In re Eynde, 480 F.2d 1364, 178 USPQ 640 (CCPA 1973).

In the present case, after reviewing the disclosure as set for in the specification and the invention as seen in the drawings of the application from the perspective of one of ordinary skill in the art, and having considered the examiner's position as set forth on pages 3-6 of the answer, we are of the opinion that the examiner has not met his burden of advancing acceptable reasoning inconsistent with enablement. More particularly, we are in agreement with appellant's arguments in the brief and reply brief that the examiner has misconstrued the claim language "switching state" as being applicable to the control system as a whole instead of to the position or state of the switch (9) on the operating lever (3).

In our view the language of claim 1 on appeal itself makes clear that the controller "tilts said mast when said operating lever is tilted and said switch is in a first switching state" or

"lifts or lowers said fork when said operating lever is tilted and said switch is in a second switching state," and "prevents lifting and lowering of said fork when said switch is changed from said first switching state to said second switching state while said operating lever is tilted" (emphasis added). The specification, pages 3-6, in our view, confirms this understanding of the claim language. Thus, appellant's characterization of the claim language as noted on pages 5 and 6 of the brief and in the reply brief is correct and resolves the enablement issue before us on appeal.

Accordingly, after a careful consideration of appellant's disclosure and of the arguments on both sides, it is our opinion that the level of skill in this art is sufficiently high that the ordinarily skilled artisan would have been able to make and use appellant's claimed invention as set forth in the claims on appeal based on appellant's disclosure and without the exercise of undue experimentation.

For the above reasons, we will not sustain the examiner's rejection of claims 1 and 2 under 35 U.S.C. § 112, first paragraph, as being based on a non-enabling disclosure.

In light of the foregoing, the decision of the examiner is REVERSED.

REVERSED

CHARLES E. FRANKFORT)
Administrative Patent Judge)
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WILLIAM F. PATE, III) APPEALS
Administrative Patent Judge) AND
) INTERFERENCES
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